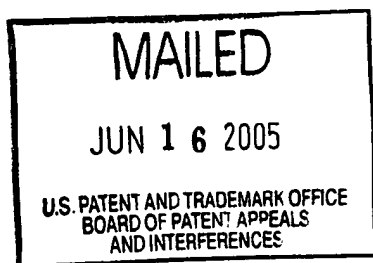


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte CHARLES P. THACKER
and
RALPH SOMMERER

Appeal No. 2005-1133
Application 09/410,414

HEARD: June 8, 2005

Before THOMAS, BLANKENSHIP, and NAPPI, Administrative Patent Judges.

THOMAS, Administrative Patent Judge.

DECISION ON APPEAL

Appellants have appealed to the Board from the examiner's final rejection of claims 1 through 14, 18 through 27, and 29 through 33, the examiner having objected to claims 15 through 17 and 28.

Representative claim 1 is reproduced below:

1. A computer-implemented method comprising:

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processing a document of at least text as a plurality of segments;

determining a plurality of page breaks within a predetermined segment;

rendering a predetermined page within the predetermined segment; and

displaying the predetermined page.

The following references are relied on by the examiner:

Barker et al. (Barker)	4,739,477	Apr. 19, 1988
Chirokas et al. (Chirokas)	5,111,397	May 5, 1992

Claims 1 through 14, 20 through 27 and 30 through 33 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Barker. Dependent claims 18, 19 and 29 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner relies upon Barker in view of Chirokas.

Rather than repeat the positions of the appellants and the examiner, reference is made to the Brief and Reply Brief for appellants' positions, and to the Answer for the examiner's positions.

OPINION

For the reasons expanded upon here, we sustain the two examiner-stated rejections of the respective claims under 35 U.S.C. § 102 and 35 U.S.C. § 103.

Page 3 of the principal Brief on appeal indicates that all claims fall together. What is actually argued, however, is the subject matter of the respective independent claims 1, 6, 12, 20, 23, 26 and 30 respectively in selective groups. There are no arguments presented as to any dependent claim rejected under 35 U.S.C. § 102, and the separately stated rejection of dependent claims 18, 19 and 29 under 35 U.S.C. § 103 has not been contested in any position in the Brief and Reply Brief.

Initially, from our study of the claims on appeal, method independent claim 1 appears to be mirrored in machine readable medium claim 20. Corresponding recitations also appear between independent claim 6 and independent claim 23, with an apparent attempt to broadly correlate the subject matter of independent claim 12 with that recited in independent claim 26. Device independent claim 30 does not correspond to any other independent claim.

With the foregoing in mind, appellants' arguments in the Brief and Reply Brief repeatedly urge that Barker does not teach a segment as recited in the claims, does not teach determining a plurality of page breaks within a predetermined segment, fails to teach processing a document as a plurality of segments

and the capability of dynamically paginating as set forth in the claims is allegedly not taught in Barker.

With respect to the last-noted urged distinction, there is no recitation in the body or even the preamble of independent claim 1 of any dynamic pagination. The feature of dynamic pagination is present in independent claim 6 in the preamble only and not required by the body of this claim. There is also no display required in claim 6. The same may generally be said of independent claim 12. Independent claim 20 is like claim 1 and independent claim 23 is like claim 6, while independent claim 26 is somewhat like independent claim 12. There is also no recitation of dynamic pagination in independent claim 30. Even though these claims do not positively recite dynamic pagination, Barker clearly teaches this anyway in the context of the dynamic editing capability taught throughout the reference.

The middle of the Abstract of Barker indicates that a superblock is any displayable area containing two or more object sets such that the object sets overlap one another, reside side-by-side or extend above or below one another. This latter feature suggests the ability of pagination. Indeed, the discussion relied upon by the examiner at column 12 with respect

to Figure 8 and at least the showings in Figure 11A-11C relied upon also by the examiner indicate that a superblock (a segment as claimed) may comprise a plurality of pages within a given superblock, thus meeting two of the principal arguments raised by appellants in the Brief and Reply Brief. There is no dispute that the given electronic document of Barker may comprise a plurality of segments as claimed in the form of a plurality of superblocks. The statement at column 7, lines 9 and 10, plainly indicates that a superblock may comprise a plurality of pages where it states: "A superblock can cross page end boundaries as long as the data within the superblock can be split across pages." As argued by the examiner and as shown clearly in Figure 11C, page break notations are determined in the normal operation of the paginator of Barker. In so doing, it is clear also to the artisan that a particular page is therefore rendered or otherwise laid out for display and then displayed as required by representative independent claim 1 on appeal as well as its corresponding independent claim 20. Of the other independent claims that remain on appeal, independent claims 6, 12, 23, 26 and 30, there is no display requirement recited. Thus, because Barker plainly indicates to the artisan that a plurality of page

breaks may exist within any given superblock, the argument that Barker does not teach determining a plurality of page breaks within a pre-determined segment is misplaced.

We turn now to special consideration of independent claims 12 and 26. Independent claim 26 appears to attempt to correspond to the more particular recitation in independent claim 12 with certain subject matter of the preamble not recited. Again, because we consider the artisan would have easily determined that a claimed segment is at least a superblock within Barker, which is dynamically edited and therefore paginated to the extent recited in the preamble of independent claim 12 on appeal, there appears to be no recitation of plural segments as in independent claims 1, 6, 20 and 30 and there is no positive recitation of a plurality of page breaks within a given segment as in independent claims 1, 6, 20, 23, and 30. As to the recitation of the at least one column of a page in claims 12 and 26, it appears to us that the whole page width can comprise the broadly recited at least one column. Correspondingly, the individual slots that are recited with respect to any given column are clearly shown in Figure 11 and the other figures as well to comprise individual lines (line slots) comprising the

entire width of or one column of the page. Figure 11C clearly shows the denotation of a page break as required at the end of these claims. The corresponding discussion of Figure 11 as well as the teaching with respect to Figure 2 at column 9 clearly indicates that the pouring of text into the predetermined slots of a given segment corresponds to the ability shown in Figure 11 of text to flow from one page to the next during the editing operations.

It is thus apparent to us that like the subject matter of more specific independent claims 1, 6, 20, 23 and 30, the subject matter of independent claims 12 and 26 do not recite any feature that it not taught or suggested within 35 U.S.C. § 102 to the artisan notwithstanding appellants' general urgings to the contrary in the Brief and Reply Brief.

We note in passing the following with respect to certain claims on appeal even though we recognize that they form no part of the subject matter of any issue presented for us on appeal. Each of these claims would have been subject to rejections available within the second paragraph of 35 U.S.C. § 112. The dependency of dependent claim 21 to claim 12 appears to be clearly in error since recitation of a medium in the

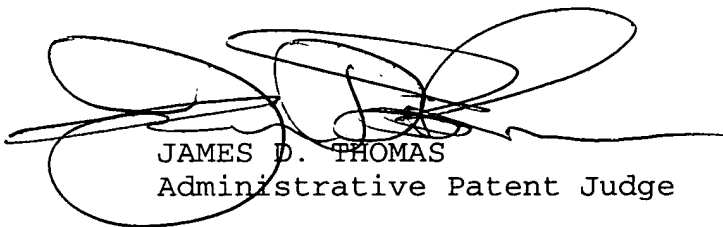
preamble of dependent claim 21 clearly follows the recitation of the medium of independent claim 20 which immediately precedes it. Independent claim 26 in the pouring text clause recites "the segment" which clearly has no antecedent basis in any recitation in that claim. To the extent appellants intend claim 26 to mirror the subject matter of independent claim 12, it is clearly evident that substantial subject matter has been left out or intentionally not recited in the preamble of claim 26. Lastly, independent claim 30 would have been clearly indefinite since it recites plural instances in which the language "to" is used to modify various verb forms, thus indicating that actions are not positively recited in a present tense in the body of the claim and, therefore, they may never be positively required in any instance. Clearly, there is no clear notice to the public for infringement avoidance purposes of what if any of the clauses recited in claim 30 to avoid.

In view of the foregoing, the decision of the examiner rejecting certain claims under 35 U.S.C. § 102 and 35 U.S.C. § 103 is affirmed.

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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a).

AFFIRMED


JAMES D. THOMAS
Administrative Patent Judge


HOWARD B. BLANKENSHIP
Administrative Patent Judge


ROBERT E. NAPPI
Administrative Patent Judge

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